



17 DEC 2007

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Andrus, Sceales, Starke & Sawall, LLP
100 East Wisconsin Avenue, Suite 1100
Milwaukee, WI 53202

In re Application of	:	
MINNICH, et al.	:	
Serial No.: 10/580,812	:	DECISION ON PETITION
PCT No.: PCT/US04/39515	:	UNDER 37 CFR 1.47(a)
Int. Filing Date: 24 November 2004	:	
Priority Date: 26 November 2003	:	
Atty Docket No.: 4553-00025	:	
For: METHOD FOR PRODUCTION OF HIGH	:	
PRESSURE STEAM FROM PRODUCED	:	
WATER	:	

This decision is issued in response to applicant's "Petition under Rule 37 CFR 1.47(a) to Accept Filing When Inventor Refuses to Sign" filed 01 August 2007 to accept the application without the signature of joint inventors, Keith R. Minnich; Mark C. Nicholson; and Ramkumar Karlupudi.

BACKGROUND

On 24 November 2004, applicant filed international application PCT/US04/39515 which claimed priority to a previous application filed 26 November 2003. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee in the United States was to expire 30 months from the priority date, 26 May 2006.

On 25 May 2006, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a copy of the international application; and a preliminary amendment.

On 01 February 2007, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed.

On 01 August 2007, applicant filed the present petition under 37 CFR 1.47(a) to accept the application without the signature of joint inventors: Keith R. Minnich; Mark C. Nicholson; and Ramkumar Karlupudi.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor. Applicant has satisfied items (1), (3) and (4).

Regarding item (1), applicant has only provided payment of \$130.00 for the petition fee. Applicant is advised that pursuant to 37 CFR 1.17(g) the petition fee is \$200.00. As authorized, the additional \$70.00 due will be deducted from deposit account no.: 01-2000.

Regarding item (2), the petition asserts that the nonsigning inventors (Ramkumar Karlupudi; Mark C. Nicholson; and Keith R. Minnich) have refused to execute the declaration. Before a refusal to execute the application can be claimed, section 409.03(d) of the MPEP requires that the nonsigning inventor be provided with a copy of the complete application, including specification, drawings and claims. The MPEP also requires "a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made."

Here, the evidence submitted to demonstrate the nonsigning inventors' refusal to execute the application papers is contained in the declaration (of facts under 37 CFR 1.47(a)) included in the petition, and the exhibits thereto. These materials provide the required firsthand statement regarding the delivery to the nonsigning inventor of a copy of the complete application, and the nonsigning inventor's refusal to execute the application, with documentary evidence supporting the statement.

Regarding item (3) above, a clear statement of the last known address of the non-signing inventors (Ramkumar Karlupudi; Mark C. Nicholson; and Keith R. Minnich) have been provided.

Regarding item (4), section 409.03(a) of the Manual of Patent Examining Procedure ("MPEP") states that:

An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the available joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

Here, applicant has filed a declaration executed by one of the four inventors and including an unsigned signature box identifying the nonsigning inventors (Ramkumar Karlupudi; Mark C. Nicholson; and Keith R. Minnich). This declaration is treated as having been executed by the available inventors on their behalf and on behalf of the nonsigning inventor. Item (4) is therefore satisfied.


CONCLUSION

The petition under 37 CFR 1.47(a) is **GRANTED**.

As provided in 37 CFR 1.47(c), a notice of the filing of this application will be forwarded to the nonsigning inventor at his last known address of record.

A notice of the filing of the application under 37 CFR 1.47(c) will be published in the Official Gazette.

This application is being returned to the United States Designated/Elected Office for processing in accordance with this decision.



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Keith R. Minnich
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In re Application of
MINNICH, et al.
Serial No.: 10/580,812
PCT No.: PCT/US04/39515
Int. Filing Date: 24 November 2004
Priority Date: 26 November 2003
Atty Docket No.: 4553-00025
For: METHOD FOR PRODUCTION OF HIGH
PRESSURE STEAM FROM PRODUCED
WATER

Dear Keith Minnich:

You are named as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you care to join in the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

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Mark C. Nicholson
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Pewaukee, Wisconsin 53072

In re Application of
MINNICH, et al.
Serial No.: 10/580,812
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Int. Filing Date: 24 November 2004
Priority Date: 26 November 2003
Atty Docket No.: 4553-00025
For: METHOD FOR PRODUCTION OF HIGH
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WATER

Dear Mark C. Nicholson:

You are named as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you care to join in the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

A handwritten signature in black ink that reads "Anthony Smith".

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RamKumar Karlapudi
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Waukesha, Wisconsin 53189

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Int. Filing Date: 24 November 2004
Priority Date: 26 November 2003
Atty Docket No.: 4553-00025
For: METHOD FOR PRODUCTION OF HIGH
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WATER

Dear RamKumar Karlapudi:

You are named as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you care to join in the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

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